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09/815,819	03/23/2001	Wendell Brown	EVOI0009	6685

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EXAMINER

PHAN, JOSEPH T

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/815,819

Applicant(s)

BROWN ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 10-11, 15, 25, and 29 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, as originally filed, does not provide support for the invention as now claimed.

Claims 1, 11, and 29, line 13 recites "...the user is equipped for audio reception only..." and line 14 recites "...a text-to-speech module to send audio to the caller.." Applicant's specification discloses that the user receives visual text of options and hyperlinks and can then enter in text so that it can be converted into speech for the caller(see page 7 lines 22-24). Therefore the user is equipped to send and receive visual data and not only audio. Appropriate clarification or correction is required.

Furthermore claims 5 and 15, line 2 recites "...options are presented in an instant message as hyperlinks....". This would further cause 112 issues because these hyperlinks would contradict 'audio reception only..' as the user needs to be equipped for receiving visual data also so that he/she can click the hyperlink in the instant message. Appropriate clarification or correction is required.

Art Unit: 2645

Claims 10 and 25, line 2 recites "...configured for audio transmission only.." Applicant's specification discloses that the user receives visual text of options and hyperlinks (see page 7 lines 22-24). Therefore the user is equipped to send and receive visual data and not only audio. Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-33, and 36 rejected under 35 U.S.C. 102(b) as being anticipated by Wolff, Patent #5,809,128.**

Regarding claims 1 and 29, Wolff teaches a method and a computer readable storage medium storing instructions for controlling a telephone call to an instant messaging user, comprising:

receiving at a call server a call directed to the user and identifying an instant messaging service used by the user (24, 30, and 32 of Fig.2);

sending an instant message to the user through the instant messaging service to offer the user one or more options for responding to the call (Fig.4);

if no response is received from the user within a predetermined period of time, controlling the call as specified in a default option (40 Fig.2); and otherwise:

Art Unit: 2645

receiving an option selection from the user; and controlling the call as specified in said selected option (42 Fig.2); and

wherein when the user selects an option to answer the call and the user is equipped for audio reception only, then said controlling step executes a text-to-speech module to send audio to the caller to allow communication between the user and the caller(50 Fig.2 and col.5 lines 1-6).

Regarding claim 2, Wolff teaches the method of claim 1, further comprising determining a user name of the user for the instant messaging service (col.3 lines 51-68).

Regarding claim 3, Wolff teaches the method of claim 1, wherein said one or more options include one or more of the set of transfer the call, answer the call, take a message from the caller and play a message for the caller (Fig.4)

Regarding claim 4, Wolff teaches the method of claim 1, wherein said option selection is received in an instant message from the user (Fig.4)

Regarding claim 5, Wolff teaches the method of claim 1, wherein said selected option is presented in said instant message as a hyperlink and said receiving said option selection comprises receiving a communication connection initiated by the user's selection of said selected option (*Fig.4-10*)

Regarding claim 6, Wolff teaches the method of claim 1, wherein said selected option is to play a message for the caller, the method further comprising recording a message from the user (col.5 lines 1-6)

Regarding claim 7, Wolff teaches the method of claim 1, wherein said selected option is to play a message for the caller and said controlling comprises:

Art Unit: 2645

converting a textual message provided by the user into audio; and playing said converted message for the caller (*col.5 lines 1-6*)

Regarding claim 8, Wolff teaches the method of claim 1, wherein said selected option is to answer the call and said controlling comprises:  
establishing an audio connection between the user and said call server; and  
bridging the call onto said audio connection (*Fig.4 and col.5 lines 29-37*)

Regarding claim 9, Wolff teaches the method of claim 8, wherein said audio connection is established through the instant messaging service without further action by the caller (*Fig.2 and Fig.4*)

Regarding claim 10, Wolff teaches the method of claim 8, wherein when the user is equipped for audio transmission only then said controlling further comprises:  
executing a speech-to-text module to send text of the caller's speech to the user to allow communication between the user and the caller (*col.4 lines 43-68 and col.7 lines 5-22*)

Regarding claim 11, Wolff teaches a method of handling a telephone call for a subscriber, comprising:  
receiving at a call server a call for a subscriber and identifying a first computer-implemented instant messaging system used by the subscriber (*Fig.2 and col.3 line 51-col.4 line 27*)  
sending a first instant message to the subscriber through the instant messaging system, wherein said first instant message includes a first set of options for

Art Unit: 2645

handling the call and one or more of said first set of call handling options comprise links to said call server(Fig.4 and col.4 line 43-col.4 line 6) if the subscriber selects one of said first set of call handling options: receiving a communication connection from the subscriber, wherein said connection is initiated by the subscriber's selection of a call handling option that comprises a link; and handling the call as specified in said selected call handling option (Fig.4 and col.4 lines 43-68); and

wherein when the user selects an option to answer the call and the user is equipped for audio reception only, then said controlling step executes a text-to-speech module to send audio to the caller to allow communication between the user and the caller (col.5 lines 1-6)

Regarding claim 12, Wolff teaches the method of claim 11, further comprising:

if the subscriber does not respond to said first instant message within a predetermined period of time, handling the call as specified in a default call handling option (40 Fig.2).

Regarding claim 13, Wolff teaches the method of claim 11, further comprising: identifying the user by an original called number field of the call (28 Fig.2 and col.5 lines 43-65)

Regarding claim 14, Wolff teaches the method of claim 11, further comprising: identifying the caller by a caller identification field of the call; wherein said first instant message includes an identifier of the caller (col.3 lines 51-68)

Art Unit: 2645

Regarding claim 15, Wolff teaches the method of claim 11, wherein said links are hyperlinks to said call server (*Fig.4*)

Regarding claim 16, Wolff teaches the method of claim 11, wherein said receiving a call comprises receiving a call forwarded to said call server from a subscriber number originally dialed by the caller (*Fig.4-11*)

Regarding claim 17, Wolff teaches the method of claim 11, further comprising retrieving user names of the subscriber for one or more instant messaging systems (*col.3 line 51-col.4 line 27*)

Regarding claim 18, Wolff teaches the method of claim 11, further comprising sending a second instant message to the subscriber through an instant messaging system different from said first instant messaging system, wherein said second instant message comprises a second set of call handling options (*46 Fig.3, Fig.4 options, Fig.10, and col.6 lines 17-45 when transferred to a different number*).

Regarding claim 19, Wolff teaches the method of claim 18, further comprising: if the subscriber selects one of said second set of call handling options:  
receiving a return instant message from the subscriber, wherein said return instant message includes an identifier of a call handling option selected by the subscriber; and handling the call as specified in said selected call handling option (*Fig.4 and col.6 lines 17-45*)

Regarding claim 20, Wolff teaches the method of claim 11, wherein said selected call handling option comprises transferring the call and said handling the



Art Unit: 2645

call comprises: transferring the call from said call server to a telephone number identified by the subscriber (Fig.10, Fig.11).

Regarding claim 21, Wolff teaches the method of claim 11, wherein said selected call handling option comprises playing a message for the caller and said handling the call comprises: playing a message identified by the subscriber for the caller (Fig.8 and Fig.9)

Regarding claim 22, Wolff teaches the method of claim 21, further comprising converting said identified message from text to audio prior to said playing (*col.5 lines 1-6*)

Regarding claim 23, Wolff teaches the method of claim 21, further comprising recording said message prior to said playing (*col.5 lines 1-6*)

Regarding claim 24, Wolff teaches the method of claim 11, wherein said selected call handling option comprises answering the call and said handling the call comprises:

establishing an audio connection between said call server and the subscriber, without further action on the part of the caller; and bridging the call onto said audio connection (Fig.4 and Fig.6)

Regarding claim 25, Wolff teaches the method of claim 24, wherein when said device configured for audio transmission only and said establishing an audio connection comprises: operating a speech-to-text module to send text of the caller's speech to the subscriber (*col.7 lines 5-30*)

Regarding claim 26, Wolff teaches the method of claim 24, wherein said establishing an audio connection comprises establishing an audio connection

Art Unit: 2645

between said call server and a communication device on which the subscriber received said first instant message (Fig.4-Fig.11)

Regarding claim 27, Wolff teaches the method of claim 11, wherein said selected call handling option comprises taking a voicemail message from the caller and said handling the call comprises:  
connecting the call to a voice recording module; and recording a message from the caller (fig.4-11)

Regarding claim 28, Wolff teaches the method of claim 27, wherein the subscriber chooses to screen said voicemail message, the method further comprising establishing an audio connection between said call server and the subscriber; and bridging said audio connection onto said voice recording connection (*Fig.4,col.7 lines 5-30; voicemail is screenable*)

Regarding claim 30, Wolff teaches a call control system for handling calls in real-time, comprising:  
a call receiver module configured to receive a call directed to a subscriber,  
a database of subscriber profiles, wherein a profile for a first subscriber includes one or more user names of the first subscriber for one or more instant messaging systems (Fig.2 and col.3 line 51-col.4 line 27 and col.5 lines 52-68)  
an instant messaging module configured to send an initial instant messaging message to the first subscriber in response to receipt of a call for the first subscriber from a caller, wherein said initial instant messaging message includes a set of options for handling the call (Fig.4 and col.4 lines 43-68)

Art Unit: 2645

a voicemail module configured to record an incoming message from the caller if the first subscriber selects a voicemail option for handling the call(Fig.4); and a message playback module configured to play an outgoing message for the caller if the first subscriber selects a message playback option for handling the call (Fig.8 and col.4 lines 43-68)

an audio module configured to establish an audio connection with the first subscriber if the first subscriber selects a call handling option for answering the call(Fig.6 and col.4 lines 43-68); and

wherein said audio module is further configured to establish an audio connection with the first subscriber if the first subscriber selects a voicemail with screening option for handling the call (40 Fig.2 and Fig.4; voicemail has screening option).

Regarding claim 31, Wolff teaches the call control system of claim 30, wherein one or more of said call handling options in said initial instant messaging message comprise hyperlinks to the call control system (Fig.4)

Regarding claim 32, Wolff teaches the call control system of claim 31, further comprising a network server configured to receive a communication connection from the first subscriber initiated by the first subscriber's selection of one of said hyperlink call handling options (col.4 lines 43-68)

Regarding claim 33, Wolff teaches the call control system of claim 30, wherein said instant messaging module is further configured to receive a return instant messaging message from the first subscriber, wherein said return instant

Art Unit: 2645

messaging message includes a selection of one of said call handling options

(Fig.4-11)

Regarding claim 36, Wolff teaches call control system of claim 30, wherein said message playback module comprises a text-to-speech converter (Fig.9 and col.5 lines 1-6)

### ***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is

Art Unit: 2645

703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP  
November 13, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name and title.